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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,036	07/17/2000	Gary K. Michelson	101.0056-07000	9164

22882 7590 08/05/2002

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EXAMINER

REIP, DAVID OWEN

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,036

Applicant(s)

MICHELSON, GARY K.

Examiner

David O. Reip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 538-546 is/are pending in the application.
- 4a) Of the above claim(s) 542 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 539, 541, 545 and 546 is/are allowed.
- 6) ☒ Claim(s) 538, 540, 543 and 544 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 384.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: the screw of Species 1, as seen in Fig. 24B, and the screw of Species 2, as seen in Fig. 53.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 538-541 and 543-546 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Thomas Martin on 7/11/02 a provisional election was made without traverse to prosecute the invention of Species 1, claims 538-541 and 543-546. Affirmation of this election must be made by applicant in replying to this Office action. Claim 542 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 538, 540, and 543 are rejected under 35 U.S.C. 102(b) as being anticipated by Trebing et al (U.S. Pat No. 5,601,553). Figs. 7 and 8 of Trebing show a plate 1 and a bone screw 24 comprising a head 20, a tip 21, a shaft 19, and a thread 23, wherein the root diameter of the first shaft portion proximate the tip is less than the root diameter of the second shaft portion proximate the head, and wherein the tread has an outer diameter that is generally uniform along at least a substantial portion of each of the first and second shaft portions, and wherein the base of the thread is smaller proximate the second shaft portion than proximate the first shaft portion. With respect

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to claim 540, Fig. 8 shows the thread having opposed side faces intersecting at an angle to form a crest along at least a portion of the length of the second shaft portion proximate the head. With respect to claim 543, it appears that the thread in at least the first shaft portion has side faces that form an included angle of approximately 30 degrees.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 544 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trebing et al. Trebing et al shows a device that is basically the same as that recited in claim 544. However, Trebing et al does not specifically disclose any range of thicknesses of the thread base. It is generally seen to be well within the level of the skilled artisan to build a particular device to any usable size, based upon application. Therefore, it would

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have been obvious to one of ordinary skill in the art at the time the invention was made to build the plate and screw device of Trebing et al in a variety of sizes to accommodate differently sized patients, wherein at least one of the usable sizes has a thread base thickness in the range of 0.25 mm to 0.60 mm.

The courts have concluded that a change in dimension, degree, size, shape, etc. without special functional significance is not patentable. *Research Corp. v. Nasco Industries, Inc.*, 501 F2d 358; 182 USPQ 449 (CA 7), cert. denied 184 USPQ 193; USLW 3359 (1974), *In re Rose*, 105 USPQ 137, and *In re Aller et al.*, 105 USPQ 233.

Allowable Subject Matter

Claims 539, 541, 545 and 546 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bidwell shows a screw having a tapered shaft and uniform diameter threads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip at (703) 308-3383. The examiner can normally be reached Mon-Thu and every other Fri from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The fax number for this Unit is (703) 308-2708 (unofficial) or (703) 872-9302 (official). The examiner can also receive direct-to-computer faxes at 703-746-3310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858.

A handwritten signature in black ink, appearing to read "David O. Reip". The signature is fluid and cursive, with a large initial "D" and a stylized "R".

David O. Reip
Primary Examiner
July 22, 2002